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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.      | CONFIRMATION NO. |
|---|-------------|----------------------|--------------------------|------------------|
| 10/811,082  | 03/26/2004  | Thomas Aisenbrey     | INT03-010                | 9725             |
| 7590 01/10/2006<br>STEPHEN B. ACKERMAN<br>25 DAVIS AVENUE<br>POUGHKEEPSIE, NY 12603 |             |                      | EXAMINER<br>LEE, KYUNG S |                  |
|   |             |                      | ART UNIT<br>2832         | PAPER NUMBER     |

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/811,082

Applicant(s)

AISENBREY

Examiner

Richard K. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 1-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/26/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of Group II in the reply filed on October 24, 2005 is acknowledged. The traversal is on the ground(s) that "Product claims are directed to 'a switching device' and the process claims are directed to 'a method to form a switching device' that "it is necessary to obtain claims in both the product and method claim language." Applicant further argues, "The field of search must necessarily cover both the method class/subclass 29/622 and product class 200/262 in addition to other related classes and subclasses to provide a complete and adequate search. Applicant even further argues, "reasons" provided in the previous action "is speculative and has nothing to do with the claims as presented in this application" and "insufficient to place additional cost to of a second patent application upon the applicant." This is not found persuasive. First, applicant mistakenly believes that the break down of divergent inventions is merely between "a switching device" and "a method to form a switching device." This is simply not true. Searching for the method claims alone, as claimed, requires understanding of the method art since molding, injecting, curing and other method steps are involved. Adding further complexity, Applicant includes a totally

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different method of "extruding" further including shaping and cutting. Second, search involved for this case is NOT merely searching class 29, 200 and few other additional art class. Multiple classes are involved for the product claims (class 200 being just one of many) and other multiple classes are involved for the method claims (class 29 being one of many). Method claims alone for injection-molding verses extruding requires separate searches to provide "a complete and adequate search," as stated by the applicant. Requesting the examiner to examine and search these divergent subject matter places undue burden on the examiner by the applicant. Third, the process of injection molding to form a plastic model toy car is NOT speculative but it most definitely meets the requirement of the MPEP pertaining to a reason for distinctness that the process as claimed can be used to make other and materially other product. As for the alternative method, US pat. 4,556,623, to Tamura et al., teaches conductive film produced by sputtering (col. 1 line 20).

For the above reasons the requirement is still deemed proper and is therefore made FINAL.

### ***Specification***

2. The disclosure is objected to because of the following informalities: Middle of Page 21 includes a blank underline. Please provide examples of the base resin.

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Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 44-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Burgess (US Pat. 5,962,118).

Burgess teaches a method to form a switching device comprising:

providing a conductive loaded, resin material comprising conductive material in a resin (Col. 6, lines 35-65; wherein his method step are his examples.);

molding the conductive loaded resin material into a conductive pill in a switching device;

the switching device comprising:

a conductive terminal 12; and

a conductive pill 14 that moves between an open and a closed position.

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Regarding claims 45-48, Burgess teaches the conductive material ratio to be about 0.20 and about 0.40 (col. 6, lines 50-53). Wherein the conductive material comprises of conductive powder and conductive fiber (col. 6, lines 38-41).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 49-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burgess in view of Soens (US Pat. 5,397,608).

Regarding claims 49-51, Burgess teaches the claimed invention, including molding and curing (col. 7, line 65), except for the extruding in a rod shape and cutting the conductive resin material.

Soens teaches an extrusion method for forming a conductive resin material (col. 6, lines 35-42) for the purpose of shaping the thermoplastic resins (col. 3, lines 31-33).

It would have been obvious to one of ordinary skill in the art at the time of the invention to having employed the

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extrusion method as taught by Soens, since the extrusion method of Soens would have provide Burgess with the ability to shape the resin material as needed.

Regarding claims 52-53, Soens teaches a metal layer coated around the resin material (Please see claim 74.).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard K. Lee whose telephone number is (571) 272-1994. The examiner can normally be reached on Mon-Tue & Thu-Fri 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin G. Enad can be reached on (571) 272-1990. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Richard K. Lee  
Primary Examiner  
Art Unit 2832

A handwritten signature in black ink, appearing to read 'R. Lee', with a date '1/8/06' written below it.